

REMARKS

Status Of Application

Claims 1-31, 33, and 35-44 are pending in the application; the status of the claims is as follows:

Claims 1-6, 9-16, 19, and 24-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,068,183 to Freeman et al ("Freeman I") in view of U.S. Patent No. 5,990,890 to Etheredge ("Etheredge").

Claims 7, 8, 17, 18, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Etheredge as applied to claims 1 and 9 above, and further in view of U.S. Patent No. 5,380,991 to Valencia et al ("Valencia").

Claims 21-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Etheredge and Valencia as applied to claims 7 and 17 above, and further in view of U.S. Patent No. 5,359,182 to Schilling ("Schilling").

Claims 27, and 29-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Etheredge as applied to claims 1 and 9 above, and further in view of U.S. Patent No. 5,841,418 to Bril et al ("Bril").

Claim 33 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Bril, as applied to claim 27 above, and further in view of Schilling.

Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Bril and Etheredge as applied to claim 27 above, and further in view of U.S. Statutory Registration No. H1173 to Davis et al ("Davis").

Claims 35-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,019,284 to Freeman et al ("Freeman II") in view of Davis.

Claims 40-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman II in view of Davis, as applied to claim 35 above, and further in view of U.S. Patent No. 6,557,107 B1 to Kim ("Kim").

Claims 45-47 have been added to more distinctly claim the invention.

Applicants respectfully request approval of the new Formal Drawings (Letter to the Official Draftsperson) filed with the application on January 25, 2001.

Claim Amendments

Claims 1, 3-7, 9, 11, 16, 17, 19, 20, 24-27, 35 and 40 have been amended to more particularly point out and distinctly claim the subject matter of the invention. Claims 2 and 33 have been cancelled and new claims 45-47 have been added. These changes do not introduce any new matter.

35 U.S.C. § 103(a) Rejections

The rejection of claims 1-6, 9-16, 19, and 24-26 under 35 U.S.C. § 103(a), as being unpatentable over Freeman I in view of Etheredge, is respectfully traversed because there is no motivation to make the combination and because the combination fails to teach the elements of the rejected claims.

There is no motivation to combine Freeman I and Etheredge because the references are from non-analogous arts. This is evident from the fact that Freeman I and Etheredge have different classifications and that there is no overlap between their respective fields of search. Moreover, Freeman I is directed to a smart card device which is typically battery powered and therefore has restricted capabilities, e.g., processing power, display type, etc. (Freeman I, abstract). In contrast, Etheredge is directed to a user interface for a computer or other device connected to a television. For example, the computer in Etheredge includes keyboard 142, mouse 144, game device 146, smart card reader 160, printer interface 150, network interface 152, TV/VCR control 154, remote control interface 156,

a resource limited device such as Freeman's smart card would not be inclined to look to arts wherein the resources are, comparatively speaking, unlimited. Indeed, it is respectfully submitted that one would be disinclined to look to such arts. Therefore, there is no motivation to combine Freeman I and Etheredge as suggested in the Office Action.

Moreover, even assuming *arguendo* that the skilled artisan would look to Etheredge, there would be no suggestion to modify Freeman I as suggested in the Office Action. Freeman teaches a smart card having a simple user interface appropriate for such a device (Fig. 1A). Etheredge teaches using computer 100, which includes smart card reader 160, to provide a rich and powerful user interface (Abstract, Fig. 2, and column 5, lines 30-46). Taking each reference in its entirety, it is respectfully submitted that the proposed combination does not suggest shoehorning the user interface taught by Etheredge into the smart card taught by Freeman I. Rather, Etheredge explicitly suggests providing a rich and powerful user interface in a device capable of reading smart cards. Freeman I also suggests that some interfaces, e.g., network communications, are provided by smart chip reader 34 rather than by the smart card itself (column 4, lines 40-47).

Furthermore, the combination expressly teach away from the amended claims. Claim 1 has been amended to incorporate the limitations of claim 2. With respect to claim 1, the Examiner alleges that Freeman teaches the device as claimed but does not teach "that the second display information is changed from being displayed only on the second display area of the display to being displayed on both the first and second display area when the operational element has not been operated for a predetermined amount of time." With respect to the limitations of claim 2, the Examiner alleges that "Freeman I teaches that the second display information is advertising information" (Office Action, page 3).

The Examiner alleges Etheredge teaches a pop-up menu that reads on the limitation of displaying an advertisement over a larger portion of the display after a period of inactivity. It is respectfully submitted, however, that Etheredge actually teaches away from this limitations of amended claim 1. For example, Etheredge teaches television

listing guide 220 which includes advertisement 222 (Fig. 4). Etheredge further teaches that if the user explicitly selects advertisement 222, further information about the advertisement is displayed (Fig. 7, item 384; and column 10, lines 36-38). However, it does not teach or suggest that advertisement 222 is displayed on a larger portion of the screen following a predetermined period of inactivity. Indeed, Etheredge explicitly teaches that the display of television listing guide 220, including advertisement 222, is terminated after a predetermined period of inactivity or after some user input (column 10, lines 5-7). Thus, Etheredge teaches that advertisements are removed from the display after a period of time or when a user operates the device. Accordingly, it is respectfully submitted that the combination of Freeman I and Etheredge fails to teach “a controller . . . configured to control the display panel so that . . . advertising information . . . is changed from being displayed only on the second display area of said display panel to being displayed on both the first and second display areas of said display panel at least when said operational element has not been operated for a predetermined amount of time”

Therefore the combination of Freeman I and Etheredge fails to teach “a controller . . . configured to control the display panel so that advertising information . . . is changed from being displayed only on the second display area of said display panel to being displayed on both the first and second display areas of said display panel at least when said operational element has not been operated for a predetermined amount of time” Accordingly, it is respectfully submitted that claim 1 and claims 2-3, which depend from claim 1, distinguish over the combination of Freeman I and Etheredge.

With respect to claim 4, it is respectfully submitted that the combination of Freeman I and Etheredge are distinguished for at least the same reasons as provided regarding claim 1, from which claim 4 depends. Moreover, the fact that the Freeman I chip card may be used to store electronic tickets or the location of a hot dog stand at a ball game would not require that the controller be configured to inhibit the user from turning off the display, for the simple reason that the user could turn the display back on and or

recall the information (column 4, lines 10-14). Accordingly, is respectfully submitted that claim 4 distinguishes over the combination of Freeman I and Etheredge.

With respect to claim 5, it is respectfully submitted that the combination of Freeman I and Etheredge are distinguished for at least the same reasons as provided regarding claim 1, from which claim 5 depends. Moreover, the Freeman I does not teach that the controller is "configured to update the advertising information when power necessary for operating said apparatus can be supplied even if the second display information is up to date," as alleged in the Office Action (page 5). Rather, the cited paragraph merely teaches that a microcontroller drives the display and may select the voltage polarity applied to the rows and columns of the display (column 6, lines 47-58). Indeed, Freeman I teaches away from the limitations of claim 5 by suggesting that chip card, including display 14, can withstand flexing of the type and magnitude experienced during normal use, handling, and storage without affecting the display (column 7, lines 1-8). Accordingly, is respectfully submitted that claim 5 distinguishes over the combination of Freeman I and Etheredge.

With respect to claim 6, it is respectfully submitted that the combination of Freeman I and Etheredge are distinguished for at least the same reasons as provided regarding claim 1, from which claim 6 depends. Moreover, it is respectfully submitted that Freeman I does not teach a detachable memory device in which *the advertisements are stored*, and therefore fails to teach "a memory for storing the advertising information, said memory being detachable from said apparatus." Accordingly, is respectfully submitted that claim 6 distinguishes over the combination of Freeman I and Etheredge.

With respect to claim 9, it is respectfully submitted that for at least the same reasons as provided regarding claim 1, Freeman I and Etheredge fail to teach "a controller for controlling said first display portion and said second display portion to both display the advertising information when said apparatus is not operated for a predetermined amount of

time.” Accordingly, is respectfully submitted that claim 9 and claims 10-14, which depend from claim 9, distinguish over the combination of Freeman I and Etheredge.

With respect to claim 15, it is respectfully submitted that the combination of Freeman I and Etheredge are distinguished for at least the same reasons as provided regarding claim 9, from which claim 15 depends. Moreover, it is respectfully submitted that Freeman I does not teach “control means *for inhibiting simultaneous performing of communication via said reception circuit for radio communication and updating of at least one of said first display portion and said second display portion,*” as alleged. The cited portions merely teach that the communication may be wireless. In fact, Freeman I explicitly teaches that communicating and other functions may be performed simultaneously (column 4, lines 21-22). Accordingly, is respectfully submitted that claim 6 distinguishes over the combination of Freeman I and Etheredge.

With respect to claim 16, it is respectfully submitted that the combination of Freeman I and Etheredge are distinguished for at least the same reasons as provided regarding claim 9, from which claim 16 depends. Moreover, it is respectfully submitted that Freeman I does not teach a detachable memory device in which *the advertisements* are stored, and therefore fails to teach a memory “wherein said advertising information is stored in said memory, said memory is detachably attachable to said apparatus, and said reception device receives the advertising information from said memory.” Accordingly, it is respectfully submitted that claim 16 distinguishes over the combination of Freeman I and Etheredge.

With respect to claim 24, it is respectfully submitted that for at least the same reasons as provided regarding claim 1, Freeman I and Etheredge fail to teach a controller “configured . . . to display advertising information in a second portion of said display when said operational element has been operated, and to display said advertising information in both the first portion and a second portion of said display at least when said operational element has not been operated for a predetermined amount of time.”

Accordingly, it is respectfully submitted that claim 24 distinguishes over the combination of Freeman I and Etheredge.

With respect to claim 25, it is respectfully submitted that for at least the same reasons as provided regarding claim 1, Freeman I and Etheredge fail to teach controller “. . . configured to update the display so that advertising information is displayed in both said first and said second display areas when said operational element has not been operated for a predetermined amount of time.” Accordingly, it is respectfully submitted that claim 25 and claim 26, which depends from claim 25, distinguish over the combination of Freeman I and Etheredge.

Accordingly, it is respectfully requested that the rejection of claims 1-6, 9-16, 19, and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Etheredge, be reconsidered and withdrawn.

The rejection of claims 7, 8, 17, 18, and 20 under 35 U.S.C. § 103(a), as being unpatentable over Freeman I in view of Etheredge as applied to claims 1 and 9 above, and further in view of Valencia, is respectfully traversed because the combination fails to teach all elements of the rejected claims.

With respect to claim 7, it is respectfully submitted that the combination of Freeman I and Etheredge are distinguished for at least the same reasons as provided regarding claim 1, from which claim 7 depends. Valencia does not provide the missing teachings, nor does it teach that an electronic device detects the presence of a discount service related to the purchase price or usage charge *of the electronic apparatus itself*. Valencia teaches a smart card that contains electronic coupons. When items are scanned for purchase it is determined whether the smart card contains a coupon for the scanned items. If there is such a coupon, it is deducted from both the purchase price and from the smart card (column 3, lines 19-34). Moreover, by teaching that the determination is performed by a central computer or card reader, Valencia teaches away from modifying Freeman's smart card to detect such discounts. Accordingly, the combination of Freeman

I, Etheredge, and Valencia fails to teach or suggest “a detector for detecting information indicative of the presence or absence of reception of at least one of a discount service regarding a price of the electronic apparatus and a discount service related to a usage charge of the electronic apparatus.” Accordingly, claim 7 and claim 8, which depends from claim 7, distinguish the cited combination of references.

With respect to claim 17, it is respectfully submitted that the combination of Freeman I and Etheredge are distinguished for at least the same reasons as provided regarding claim 9, from which claim 17 depends. It is further respectfully submitted that claim 17 distinguishes the combination of Freeman I, Etheredge, and Valencia for at least the same reasons as applied above in regard to claim 7. Accordingly, claim 17 and claim 18, which depends from claim 17, distinguish over the combination of Freeman I, Etheredge, and Valencia.

With respect to claim 20, it is respectfully submitted that for at least the same reasons provided above regarding claims 1, 7, 9, and 17 the combination of Freeman I, Etheredge, and Valencia fail to teach “actuating said controller to display an advertisement on said display panel so that the advertisement occupies a smaller fraction of the display panel when said electronic device is being operated and a larger fraction of the display panel when said electronic apparatus is not being operated,” and determining a service condition “selected from the group consisting of a purchase price discount service *of said electronic apparatus*, [and] a usage charge discount service *of said electronic apparatus*.” Moreover, none of the references refer to “a predetermined payment contract *of said electronic apparatus*.” Accordingly, claim 20 distinguishes over the combination of Freeman I, Etheredge, and Valencia.

Accordingly, it is respectfully requested that the rejection of claims 7, 8, 17, 18, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Etheredge as applied to claims 1 and 9 above, and further in view of Valencia, be reconsidered and withdrawn.

The rejection of claims 21-23 under 35 U.S.C. § 103(a), as being unpatentable over Freeman I in view of Etheredge and Valencia as applied to claims 7 and 17 above, and further in view of Schilling, is respectfully traversed because the cited references fail to teach all limitations of the rejected claims.

With respect to claim 21, it is respectfully submitted that for at least the same reasons provided above regarding claim 7, the combination of Freeman I, Etheredge, and Valencia fails to disclose that the electronic device takes any action based on “the presence or absence of the discount service.” Therefore, the references fail to disclose “setting means for setting said electronic apparatus so that predetermined information is displayed on said display panel based on the presence or absence of the discount service.” It is respectfully submitted that Schilling also fails to teach this limitation of claim 21. Accordingly claim 21 and claim 22, which depends from claim 21, distinguish over the combination of Freeman I, Etheredge, Valencia, and Schilling.

With respect to claim 23, it is respectfully submitted that for at least the same reasons provided with regard to claim 21, the combination of Freeman I, Etheredge, Valencia, and Schilling fails to teach “setting said electronic apparatus so that predetermined information is displayed on said display panel based on the presence or absence of the discount service.” Accordingly claim 23 distinguishes over the combination of Freeman I, Etheredge, Valencia, and Schilling.

Accordingly, it is respectfully requested that the rejection of claims 21-23 under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Etheredge and Valencia as applied to claims 7 and 17 above, and further in view of Schilling, be reconsidered and withdrawn.

The rejection of claims 27, and 29-31 under 35 U.S.C. § 103(a), as being unpatentable over Freeman I in view of Etheredge as applied to claims 1 and 9 above, and further in view of Bril, is respectfully traversed based on the following.

With respect to claim 27, it is respectfully submitted that for et least the same reasons provided above regarding claims 1 and 7, the combination of Freeman I and Etheredge fails to teach a controller “configured to control said first display portion and said second display portion so that . . . advertising information is displayed on both of said first and said second display portions at least when said terminal is not operated for a predetermined amount of time.” It is further submitted that Bril does not cure this deficiency. Accordingly, claim 27 and claims 29-31, which depend from claim 27, distinguish the combination of Freeman I, Etheredge, and Bril.

Accordingly, it is respectfully requested that the rejection of claims 27, and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Etheredge as applied to claims 1 and 9 above, and further in view of Bril, be reconsidered and withdrawn.

With respect to claim 33, which has been cancelled, the rejection of claim 33 under 35 U.S.C. § 103(a), as being unpatentable over Freeman I in view of Bril, as applied to claim 27 above, and further in view of Schilling, is respectfully traversed as being moot.

The rejection of claim 28 under 35 U.S.C. § 103(a), as being unpatentable over Freeman I in view of Bril and Etheredge as applied to claim 27 above, and further in view of Davis, is respectfully traversed because the combination of references fails to teach the elements of claim 28.

With respect to claim 28, it is respectfully submitted that claim 28 distinguishes over the combination of Freeman I, Etheredge, and Bril for at least the same reasons provided above with respect to claim 27, from which claim 28 depends. It is further submitted that Davis fails to provide the teaching that is missing from the other references. Accordingly, claim 28 distinguishes over the combination of Freeman I, Etheredge, Bril, and Davis

Accordingly, it is respectfully requested that the rejection of claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Freeman I in view of Bril and Etheredge as applied to claim 27 above, and further in view of Davis, be reconsidered and withdrawn.

The rejection of claims 35-39 under 35 U.S.C. § 103(a), as being unpatentable over Freeman II in view of Davis, is respectfully traversed because there can be no motivation to make the suggested combination.

With respect to claim 35, it is respectfully submitted that the combination of Freeman II and Davis fails to teach a communication apparatus in which communications and writing to a display are prevented from occurring concurrently. Freeman II teaches a chip card that communicates digital data with another device, e.g., a card reader. Davis teaches a selective call receiver, e.g., a pager, in which multiple alerting devices are operated alternately rather than concurrently so as to improve battery power. However, Davis does not teach to prevent radio communications at the same time as updating a display. Indeed, Davis teaches that receiver 10 and bit synchronization circuit 14 cooperate to receive a bit stream encoded using the POCSAG format. Code word detector 16 and decoding controller 20 cooperate to search the bit stream for the occurrence of code words and addresses. When code word detector 16 detects an address function, one or more alert signals are generated. (Davis, column 2, lines 34-67).

The POCSAG format transmits address data followed immediately by the message data (See Fig. 2 of USP 4,994,784 to Yoon). If Davis turned receiver 10 OFF when an alert is generated, i.e., when an address is detected, then the message codeword would not be received, defeating the very purpose of the Davis device. If a "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP 2143 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Modifying Davis as suggested in the Office Action would clearly render Davis' pager inoperable as a pager. Therefore, Freeman II and Davis may not be combined as

suggested. Accordingly, claim 35, as well as claims 36-39 which depend therefrom, distinguish the combination of Freeman II and Davis.

Accordingly, it is respectfully requested that the rejection of claims 35-39 under 35 U.S.C. § 103(a) as being unpatentable over Freeman II in view of Davis, be reconsidered and withdrawn.

The rejection of claims 40-44 under 35 U.S.C. § 103(a), as being unpatentable over Freeman II in view of Davis as applied to claim 35 above, and further in view of Kim, is respectfully traversed because there can be no motivation to make the proposed combination and because the combination fails to teach all limitations of the rejected claims.

With respect to claim 40, it is respectfully submitted that for at least the same reasons as provided above with regard to claim 35 the combination of Freeman II and Davis is improper. However, assuming *arguendo* that the combination is proper, the further addition of Kim fails to teach the limitations of claim 40. Kim merely teaches a method and circuit for releasing a microprocessor from a STOP mode whenever a signal on an I/O port of the microprocessor changes. This enables the microprocessor to be shut down when it has no work to do, thereby saving battery power. However, Kim is entirely devoid of any teaching regarding the timing of radio communication and driving a display. At best, the proposed combination suggests that the circuit of Kim be used to wake up the processor in Freeman II's chip card when an input or output thereof changes. Accordingly, claim 40, and claims 41-44 which depend therefrom, distinguish over the combination of Freeman II, Davis, and Kim.

Accordingly, it is respectfully requested that the rejection of claims 40-44 under 35 U.S.C. § 103(a) as being unpatentable over Freeman II in view of Davis as applied to claim 35 above, and further in view of Kim, be reconsidered and withdrawn.

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With respect to new claims 45-47, it is respectfully submitted that they distinguish the art of record for at least the same reasons as their respective parent claims.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

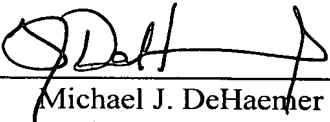
If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

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and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's
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Respectfully submitted,

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